



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
[www.uspto.gov](http://www.uspto.gov)

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/563,399	01/05/2006	Alan Berry	21841USWO(C038435/0196234	3243
7590	10/25/2007	Stephen M Haracz Bryan Cave 1290 Avenue of the Americas New York, NY 10104	EXAMINER RAGHU, GANAPATHIRAM	
			ART UNIT 1652	PAPER NUMBER
			MAIL DATE 10/25/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Advisory Action  
Before the Filing of an Appeal Brief**

Application No.	BERRY ET AL.	
Examiner	Art Unit	

Ganapathirama Raghu

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 09 October 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1.  The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

a)  The period for reply expires 4 months from the mailing date of the final rejection.  
 b)  The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2.  The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3.  The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because

- (a)  They raise new issues that would require further consideration and/or search (see NOTE below);
- (b)  They raise the issue of new matter (see NOTE below);
- (c)  They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d)  They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4.  The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).

5.  Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.

6.  Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

7.  For purposes of appeal, the proposed amendment(s): a)  will not be entered, or b)  will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: \_\_\_\_\_.

Claim(s) rejected: \_\_\_\_\_.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

**AFFIDAVIT OR OTHER EVIDENCE**

8.  The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).

9.  The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).

10.  The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11.  The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See Continuation Sheet.

12.  Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_.

13.  Other: \_\_\_\_\_.

Continuation of 11. does NOT place the application in condition for allowance because: Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gokarn et al., (WO 02/26933 A2, publication date 04/04/2002, in IDS)), in view of Yoshida et al., (J. Gen. Appl. Microbiol., 1998, Vol. 44: 19-26; in IDS) and Berry et al., (WO 02/099095 A2, publication date 12/12/2002; in IDS). Applicants' have traversed the rejection with the arguments; (A) "the rejection is devoid of any evidence- or even argument in support of the proposed combination", (B) "all claim limitations must be taught or suggested by the prior art", (C) "Berry's other disclosure is against well established precedent. A prior art reference must be considered in its entirety", and ~~(D)~~ "Yoshida et al., is at best non-analogous art and cannot be cited and at worst is irrelevant to the present claims". Applicants' arguments have been considered and are found to be non-persuasive and examiner continues to hold the position that all the cited references are in "congruence" with obviousness rejection unlike the arguments presented by the applicant, wherein in said arguments examiner is unable to find even an "iota" of evidence how the instant invention is novel and un-obvious and why the cited references do not teach every single element of the instant invention.

Reply: (A), As cited in the FINAL rejection of Office-Action dated 06/04/07, the cited references teach every single element of the instant invention such as, 1) Gokarn et al., and Yoshida et al., teach that Rhodobacter by virtue of its endogenous cellular machinery inherently possesses the increased ability to synthesize CoQ10 and amenable to transformation with mevalonate biosynthetic pathway genes and therefore, would certainly be a good host cell for enhanced production of CoQ10; 2) The reference of Berry et al., (supra) disclose the structural element of the instant invention sequence of plasmid pBR-K-mev-op-R114 comprising a mevalonate operon of a microorganism of *Paracoccus zeaxanthinifaciens*. Therefore a skilled artisan would certainly select Rhodobacter as the first choice organism for the production of CoQ10 and examiner has clearly and lucidly expressed this "obvious" point why a skilled artisan would choose Rhodobacter as the preferred cellular context as it provides all the additional advantages possibly other enzymes, cofactors and substrates for efficient production of CoQ10 and therefore under such a cellular context one would achieve optimal expression of plasmid pBR-K-mev-op-R114 comprising a mevalonate operon encoding polypeptides for the optimal production of CoQ10.

Reply: (B) & (C), The objectives of the cited references need not be the same as the instant invention to be used in an "Obviousness" rejection, the only requirement is the findings of cited prior art need to either teach or provide motivation or suggestion or elements that when combined by a skilled artisan would render the instant invention "Obvious". The cited references are also certainly directed to the production of CoQ10, wherein the studies were designed to identify and enhance the production of CoQ10 and therefore are analogous art and the elements taught in the cited prior art when combined would yield high expectation of success. Finally the KSR ruling forecloses the argument that a specific teaching, suggestion or motivation is more than enough for obviousness to try and thus provides support for finding of "Obviousness" (Ex parte Smith, --USPQ2d--, slip op. at 20, Bd.Pat. Appl. & Interfer. June 25, 2007, citing KSR USPQ2d at 1396).

*Rebecca Prouty*  
REBECCA S. PROUTY  
PRIMARY EXAMINER  
GROUP 1600  
*160*